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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,436	05/17/1999	DAVID S. SPRINGER	M-7260US	3911
7590	07/29/2004		EXAMINER	
DAVID L MCCOMBS HAYNES & BOONE LLP 901 MAIN STREET SUITE 3100 DALLAS, TX 75202-3789			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 07/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/313,436	SPRINGER ET AL.	
	Examiner	Art Unit	
	Khanh H. Le	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 March 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,4-9 and 26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1, 4-9, and 26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

Detailed Action/ Final Response to 2nd RCE

1. This Office Action is in response to the Amendment and Request for consideration dated 3/25/04.

2. As requested, amendments to claims 1, 9, and 26 have been entered.

Claims 1, 4-9, and 26 remain pending in the application. Claims 1 and 26 are independent.

Claim Rejections 35 USC 112

3. Rejection of claim 9 under the second paragraph of 35 U.S.C. 112 is withdrawn due the amendment.

Response to Remarks

4. Applicant's arguments have been fully considered but they are not persuasive. Applicants argue at length on the lack of motivation to combine. In response, the Examiner notes that proper motivation has been presented in the previous Office Action as well as in this one, and Applicants have not discussed why the presented motivations are lacking.

As to the new limitation of “the database determining incentives available to the computer user associated with the unique identifier”, GARDENSWARTZ discloses the database searching and locating targeted advertisements including incentives (see at least abstract, Figure 9 and associated text).

As to the new limitation of “the database determining options...” this phrase is understood as meaning “the database determining options... available to the computer user associated with the unique identifier”. The only support for this, from the specifications, is at page 7 line to page 8 line 10 where the options presented to the user are to participate or not in receiving incentives. All other terms such as “optionally” in the specifications in the

specifications at pages 7 to page 8 line 10 seem only to refer to different embodiments of the database. As to the options presented to the user to participate or not in receiving incentives, GARDENSWARTZ discloses such at col. 20 lines 17-19.

Thus the previous rejections are maintained with minor modifications (in bold) to fit the amended claims.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1, 4, 8-9, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al., US 6298,330 B1, hereinafter Gardenswartz in view of Jenkins, US 6285983, hereinafter Jenkins.**

As to claims 1, 8, GARDENSWARTZ discloses:

A method of tracking information provided to a computer system from an advertisement database and associated server, the method comprising:

providing an identifier unique to the computer system,
(see at least Figs. 3, 7, and associated text; col. lines. 2 ll. 9-20; col. 8 ll. 34-55: cookies and other ID methods);

the database associating the identifier (cookie) with information specific to a computer user associated with the computer system (see at least Figure 3 and associated text: “CID’s”).

the computer user establishing a web connection with the server (see at least Fig. 9 and associated text; col. 13 line 54+) and

the computer user transmitting the identifier to the database (Fig. 9 and associated text; col. 13 line 54+ ; col. 10 line 66- col. 11 l. 25)

in response the database transmitting a specific advertisements to the identified computer system (see at least Fig. 9 and associated text; col. 13 line 54+).

the database determining incentives available to the computer user associated with the unique identifier (see at least abstract, Figure 9 and associated text),

the database determining options available to the computer user (interpreted as options presented to the user to participate or not in receiving incentives) (see at least col. 20 lines 17-19) .

GARDENSWARTZ impliedly discloses the database tracking each advertisement transmitted to the identified computer system (col.15 lines 24-33).

GARDENSWARTZ does not specifically disclose the identifier is stored on a (the user's) hard drive (claim 8) or is imbedded in the user computer hardware (claim 1) however Jenkins discloses that

"As is known in the art, cookie files may be installed by a web site server on the computer hard disk drive of a browsing consumer" (see at least col. 1 lines 18-39). It would have been obvious to one skilled in the art at the time the invention was made to install the cookie file on the user hard drive to implement the user ID method of GARDENSWARTZ because such cookie implementation technique is well-known (typical) as stated in Jenkins.

Claim 4. GARDENSWARTZ discloses the method of claim 1 and further discloses the server hosting advertisements and informational data (see at least the abstract, col 7 l. 20-26: advertisements are also informational data).

(Per whatis.com, hosting is defined as :

http://searchwebservices.techtarget.com/sDefinition/0,,sid26_gci213581,00.html

“Hosting (also known as *Web site hosting*, *Web hosting*, and *Webhosting*) is the business of housing, serving, and maintaining files for one or more Web sites”).

Claim 9. The method of Claim 1 wherein information unique to the computer user includes one of incentives, bonuses and discounts on a plurality of goods (Gardenswartz, Fig 4b and associated text; col. 9 ll.27-64: specific target messages).

Claim 26 essentially claims the same steps as claim 1 in broader terms and is rejected similarly.

7. Claims 5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz in view of Jenkins as applied to claim 1 and further in view of Goldhaber et al., US 5855008, hereinafter Goldhaber.

Claim 5. GARDENSWARTZ discloses the method of claim 1 and further discloses the database searching and locating targeted advertisements (see at least Figure 9 and associated text). GARDENSWARTZ also discloses criteria provided by the computer user during a querying procedure (see at least Fig. 7 and associated text; col.11 lines 39-53:” product brand preferences”).

However GARDENSWARTZ does not specifically discloses the database searching and locating advertisements that match criteria provided by the computer user during a querying procedure. Goldhaber discloses such however (see at least Figure 11A and

associated text; col. 15 lines 1 to col. 16 lines 24-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add such ad matching as taught by Goldhaber to the GARDENSWARTZ's system to satisfy the user's interests as taught by Goldhaber (col.14 lines 65-66).

Claim 7. GARDENSWARTZ discloses the method of claim 5 and further discloses the database checks for the identifier_(Fig. 9 item 80 and associated text: matching cookie number to consumer ID implies checking the identifier for accuracy before the matching step; col. 13 line 54+ ; col. 10 line 66- col. 11 l. 25).

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz in view of Jenkins and Goldhaber as applied to claim 5, and further in view of Day et al., US 5857175 A, hereinafter Day.

As to Claim 6. GARDENSWARTZ in view of Goldhaber discloses the method of claim 5 but does not disclose if no matching criteria is found the database transmitting one of generic advertisements or no advertisements. However, Day discloses same (col. 5 lines 37-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add such feature of Day into the GARDENSWARTZ/Goldhaber system to keep the user interested in the ad delivery system (Day, col.5 line 41).

Conclusion

9. All prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

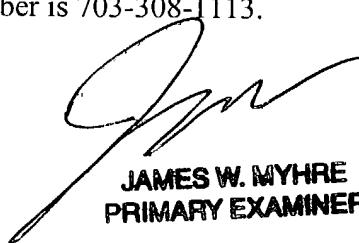
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov. (However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

July 26, 2004 *khl*
KHL



JAMES W. MYHRE
PRIMARY EXAMINER